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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,313	08/15/2001	Samuel Wharton Lessin	21822-005C	3530

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EXAMINER

GREIMEL, JOCELYN

ART UNIT	PAPER NUMBER
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3693

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,313

Applicant(s)

LESSIN, SAMUEL WHARTON

Examiner

Jocelyn Greimel

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 30 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>see attached</u> . | 6) <input type="checkbox"/> Other: _____ |

Information Disclosure Statement: 04/25/02, 10/03/02, 05/14/03.

DETAILED ACTION

1. This communication is in response to Applicant's application of August 15, 2001, which claims the benefit of 60/275,974 filed March 15, 2001 and 60/291,226 of May 16, 2001. Claims 1-17, 30 and 32 are pending and are presented to be examined upon their merits. Claims 1, 30 and 32 are independent claims.

Election/Restrictions

2. In view of Applicant's original claims 1-36, the election to one of the following inventions is deemed necessary. Restriction to one of the following inventions is required under 35 U.S.C. 121. The restrictions cited are as stated below:

- a. Group 1: Claims 1-17, 30 and 32 are drawn to a method providing funding to an individual by an investor comprising selling shares of an individual for a return of individual's income.
- b. Group 2: Claims 18-29, 31 and 33 are drawn to a method for buying and selling shares in an individual using bidding.
- c. Group 3: Claim 34 is drawn to a method of selling shares.
- d. Group 4: Claim 35 is drawn to a method for registering requests.
- e. Group 5: Claim 36 is drawn to a method of registering offers and bidding on offers.

3. The inventions are distinct, each from the other because of the following reasons:

a. Inventions 1-5 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

b. In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because, the inventions, as detailed above each have a separate utility.

c. The independent claims in each Group 1-5 recite limitations that are not found together in a common independent claim of the other group, thus it is evidence that Applicant believes a distinct invention combination lies within each set of independent claims. Also, the dependent claims then append a multiple of distinct inventive concepts for which Applicant's submission is evidence that Applicant believes each supports a distinct reason for invention. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different concepts, restriction for examination purposes as indicated is proper. Applicant is advised that the response to this requirement to be complete must include an election of one of the inventions 1-5 to be examined even though the requirement be traversed (37 C.F.R. §1.143).

5. A telephone call was made to Mr. Brian Hopkins on September 10, 2006, to request an oral election to the above restriction requirement. Mr. Hopkins elected Group I (Claims 1-17, 30 and 32) with traverse. Applicant is respectfully advised to cancel all the non-elected claims. Additionally, Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are as follows: Claim 1 relates to providing funding to an individual. The claim discusses communicating a request, associating the request with a cost for a share, offering the share for sale and the purchase of the share. Claim 1 does not disclose how the funding is provided to the individual. The claim does not set forth any steps involved in the method/process of providing the funding, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it

merely recites a use without any active, positive steps delimiting how this use is actually practiced.

3. Claims 1, 30 and 32 recite the limitation "percentage of the Seller's income". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-17, 30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Mottola et al (US Patent No. 5,809,484, hereinafter Mottola).** In reference to claims 1, 30 and 32, Mottola discloses a method, computer readable media and system for providing funding to an individual by an investor comprising: communicating a request for funding for an individual by an investor; associating said request for funding with a cost for a share in an individual, wherein a purchaser of the share receives an economic return comprising a percentage of the Seller's income; offering the share for sale; and purchasing the share by a purchaser at a purchase price

(col. 3, lines 25-58; col. 5, lines 58-67; col. 6, lines 1-29; col. 8, lines 50-67; col. 9-10; col. 11, lines 20-64; col. 13, lines 7-42).

6. In reference to claims 2-4, Mottola discloses a method of providing funding to an individual by an investor wherein: offering shares for sale comprises auctioning the share wherein purchasing the share comprises submitting a highest purchase price; wherein said highest purchase price comprises a monetary amount equal to at least the cost of the share; wherein said purchase price comprises the cost of the share and a mentoring capability of the purchaser (col. 3, lines 25-58).

7. In reference to claims 5-7, Mottola discloses a method of providing funding to an individual by an investor wherein: the individual's income comprises the individual's potential future income; the percentage of the income is variable; the percentage of the income is approximately zero (col. 9, lines 65-67; col. 10, lines 1-36).

8. In reference to claim 8, Mottola discloses the method wherein the funding request comprises at least one of college tuition, forming a business and/or developing an idea (col. 3, lines 25-58).

9. In reference to claims 9 and 10, Mottola discloses the method wherein said funding request is associated with a plurality of shares, each share being associated with a certain portion or an equal portion of the funding and a portion of the percentage of the individual's future income (col. 9, lines 1-65).

10. In reference to claims 11-13, Mottola discloses the method wherein the percentage is greater than zero and less than about fifty; greater than zero and less than about twenty-five; greater than zero and less than about ten (col. 10, lines 10-36).

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11. In reference to claims 14-17, Mottola discloses: wherein the purchaser comprising a purchasing group of a plurality of individual purchasers; wherein the percentage return is directed toward a second entity apart from said purchaser; wherein the second entity is a charitable organization; wherein the second entity is a non-profit organization (col. 3, lines 25-58; col. 10, lines 46-59).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached Monday - Friday 8:30 AM - 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached at (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jocelyn Greimel
Examiner, Art Unit 3693
September 11, 2006



ELLA COLBERT
PRIMARY EXAMINER